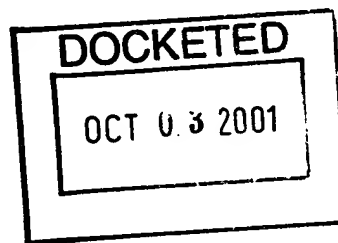




Applicant(s): McCafferty et al. Ser/Pat No.: 09/417,478 Filing/Issue Date: 10-13-99  
Docket No.: 13839-00010 Attorney: DWC/TCS Due Date: 8-30-01  
Title: Methods of Producing Members of Specific Binding Pairs  
Date Sent: 10-2-01 ☒ 1<sup>st</sup>-Class Mail ☐ U.S. P.O. Express Mail (No. \_\_\_\_\_) ☐ Hand Carried

The U.S. Patent and Trademark Office date stamped hereon is acknowledgement that the items, checked below, were received by the U.S. Patent and Trademark Office on the date stamped:

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| <input type="checkbox"/> Provisional Application for Patent Cover Sheet (____ pp)   | <input type="checkbox"/> Response to Missing Parts / Incomplete Application (____ pp)                          |
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| <input type="checkbox"/> Specification (including claims & abstract) (____ pp)  | <input type="checkbox"/> Affidavit(s)/Declaration(s) (____ pp)   |
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| <input type="checkbox"/> Combined Oath / Declaration & Power of Attorney (____ pp)  | <input type="checkbox"/> Request for Approval of Dwg. Amd's. (____ pp)   |
| <input type="checkbox"/> Assignment or _____ with Recordation Form Cover Sheet - Patents (____ pp)                                    | <input type="checkbox"/> Notice of Appeal (____ pp)  |
| <input type="checkbox"/> Fee Transmittal, in duplicate (____ pp, total)   | <input type="checkbox"/> Appeal Brief, in triplicate (____ pp, total)  |
| <input type="checkbox"/> Claim for priority and certified copies of _____ priority applications                                       | <input type="checkbox"/> Revocation/Power of Attorney (____ pp)  |
| <input checked="" type="checkbox"/> Transmittal Form (____ pp)  | <input type="checkbox"/> Certificate Under 37 CFR 3.73(b) (____ pp)  |
| <input type="checkbox"/> Response to Official Action / Amendment (____ pp) (circle one - A / B / C / Preliminary / After Final / 312) | <input type="checkbox"/> Associate Power of Attorney (____ pp)   |
| <input type="checkbox"/> Petition for _____-Month Extension of Time (____ pp)   | <input type="checkbox"/> Status Inquiry (____ pp)  |
| <input type="checkbox"/> Information Disclosure Statement (____ pp)   | <input type="checkbox"/> Petition _____ (____ pp)  |
| <input type="checkbox"/> Form PTO/SB/08A (____ pp)  | <input type="checkbox"/> Terminal Disclaimer (____ pp)   |
| <input type="checkbox"/> Cited References (____ references)   | <input type="checkbox"/> Request for Certificate of Correction (____ pp)                                       |
| <input type="checkbox"/> Issue Fee Transmittal (____ pp)  | <input type="checkbox"/> Form PTO-1050 (2 copies, ____ pp, total)  |
| <input type="checkbox"/> Check / Authorization to charge Deposit Account (\$ _____)   | <input type="checkbox"/> Maintenance Fee Transmittal (____ pp)   |
| <input type="checkbox"/> "Fee Address" Indication Form (____ pp)  |  |
- ☒ Other Change Address; Response to Communication; & Notice



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**PATENT APPLICATION**

Attorney Docket No. 13839-00010 (Previous 28111-32729B)

Date : October 2, 2001

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): McCafferty, et al.

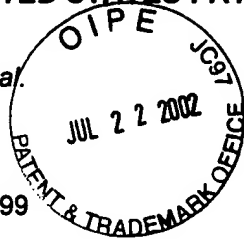
Application No.: 09/417,478

Filed: October 13, 1999

For: **METHODS OF PRODUCING  
MEMBERS OF SPECIFIC BINDING PAIRS**

Group Art Unit: 1627

Examiner: P. Ponnaluri



**CERTIFICATE OF MAILING**

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Attention: Assistant Commissioner for Patents, Washington, D.C. 20231, on this date.

10/2/01

Date

David W. Clough, Ph.D.  
Registration No. 36,107  
Attorney for Applicant(s)

**TRANSMITTAL OF PETITION**

Commissioner of Patents and Trademarks  
ATTENTION: Assistant Commissioner for Patents  
Washington, D.C. 20231

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**OFFICE OF PETITIONS**

Sir:

Transmitted herewith is a Response to Communication from Commissioner and Petition Under 37 CFR §§ 1.181 and 1.183 in the above-identified application.

1. Response to Communication From Commissioner and Petition Under 37 C.F.R. 1.181 and 1.183.
2. Change of Address Communication.
3. **Method of Payment of Fees**
  - ( ) Enclosed is our firm check in the amount of: \$ \_\_\_\_\_
  - ( ) Charge \$ \_\_\_\_\_ to Deposit Account No. 50-1214.
4. (x) The Commissioner is hereby authorized to charge any additional fees which may be required in this application under 37 C.F.R. §§1.16-1.17 during its entire pendency, or credit any overpayment, to Deposit Account No. 50-1214. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-1214. This sheet is filed in duplicate.

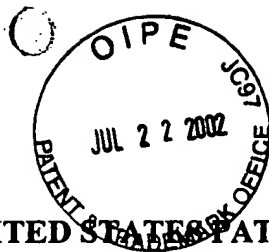
Respectfully Submitted

October 2, 2001  
(Date)

By:

David W. Clough, Ph.D.  
Registration No. 36,107

**KATTEN MUCHIN ZAVIS**  
525 West Monroe Street, Suite 1600  
Chicago, Illinois 60661-3693  
(Direct) Phone No. (312) 902-5464  
(Direct) Fax No. (312) 577-8736



PATENT

Previous Docket No. 28111/32729B  
Attorney Docket No. 13839/00010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: McCafferty *et al.*  
Application No. 09/417,478  
Filed: October 13, 1999  
Title: METHODS FOR PRODUCING  
MEMBERS OF SPECIFIC  
BINDING PAIRS  
Group Art Unit: 1627  
Examiner: P. Ponnaluri

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10/2/01

Date

David W. Clough, Ph.D.

Registration No. 36,107

Attorney for Applicant(s)

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JUL 29 2002

OFFICE OF PETITIONS

**CHANGE OF ADDRESS COMMUNICATION**

Honorable Commissioner of Patents  
Washington, D.C. 20231

Dear Sir:

Please direct all further correspondence and telephone call regarding the above patent  
application to:

David W. Clough, Ph.D.  
KATTEN MUCHIN ZAVIS  
525 West Monroe - Suite 1600  
Chicago, Illinois 60661-3693  
Tel: (312) 902-5464 Fax: (312) 577-8736

Respectfully submitted,

KATTEN MUCHIN ZAVIS

By:

David W. Clough, Ph.D.

Registration No. 36,107

Date: October 2, 2001  
525 West Monroe Street - Suite 1600  
Chicago, Illinois 60661  
Tel: (312) 902-5464  
Fax: (312) 577-8736



# 21

PATENT  
13839-00010 (28111-32729B)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: McCafferty, *et al.*

Serial No.: 09/417,478

Filed: October 13, 1999

Title: METHODS OF PRODUCING  
MEMBERS OF SPECIFIC BINDING  
PAIRS

Group Art Unit: 1627

Examiner: P. Ponnaluri

**CERTIFICATE OF MAILING**

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envelope addressed to: Assistant  
Commissioner for Patents, Washington,  
D.C. 20231, on this date.

10/02/01  
Date

David W. Clough, Ph.D.  
Registration No. 36,107  
Attorney for Applicant(s)

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Box DAC  
Assistant Commissioner of Patents  
Washington, D.C. 20231

**RESPONSE TO COMMUNICATION FROM COMMISSIONER AND PETITION  
UNDER 37 C.F.R. §§ 1.181 AND 1.183**

Dear Sir:

This paper is filed in response to the communication from the Examiner mailed July 30, 2001, in which the Examiner stated that the above-identified application failed to comply with the requirements of 37 C.F.R. §§ 1.821-1.825 (the "Sequence Listing Rules") for failing to provide an initial computer readable "Sequence Listing" and a paper copy of the "Sequence Listing." Applicants respectfully request reconsideration and withdrawal of the requirement for a Sequence Listing or in the alternative request suspension of the rules (pursuant to 37 CFR § 1.183) relating to the Sequence Listing request. It is believed that no extension of time is necessary. However, if Petitioners are mistaken, please consider this request for an extension of time for two-months and charge our Deposit Account No. 50-1214.

Application No. 09/417,478  
Filed: October 13, 1999



Docket No. 13839-00010

**A. The Sequence Listing Rules Should Be Waived With Respect To The Present Application**

The present application is a divisional application of U.S. patent application serial no. 08/484,893, now U.S. Patent No. 6,172,197 B1 (the '197 patent, "parent application"), which was a continuation of U.S. patent application serial no. 07/971,857, now U.S. Patent No. 5,969,108 (the '108 patent, "grandparent application"), which was the U.S. national stage of PCT/GB91/01134 (the '01134 application). In neither case were the Applicants required to provide a Sequence Listing.

The Applicants hereby petition under 37 C.F.R. § 1.183 that the Sequence Listing requirement, as applied by M.P.E.P. 2421.01, be waived with respect to the present application. M.P.E.P. 2421.01 states in pertinent part:

The sequence rules require the use of standard symbols and a standard format for sequence data in most sequence-type patent applications. They further require the submission of that data in computer readable form. Compliance is required for most disclosures of sequence data in new applications filed on or after October 1, 1990.

...

In exceptional circumstances, it should be noted that the Office may waive the rules via a 37 CFR 1.183 petition. (Emphasis added)

As indicated above, M.P.E.P. 2421.01 does not require that the Sequence Listing Rules be applied to ALL new applications filed on or after October 1, 1990. Instead, the Sequence Listing Rules may be waived with respect to a new application where "exceptional circumstances" exist. For the reasons stated below, the Applicants respectfully submit that "exceptional circumstances" under M.P.E.P. 2421.01 exist such that the Sequence Listing Rules should be waived with respect to the present application.

Application No. 09/417,478  
Filed: October 13, 1999



Docket No. 13839-00010

**1. Exceptional Circumstances - To provide a Sequence Listing would be unduly burdensome and a hardship**

The Applicants respectfully submit that requiring the present application to comply with the Sequence Listing Rules would place undue hardship on the Applicants. The sequence data found in the present application is currently not available in any computer readable form because the PCT application from which the present application ultimately arose was filed in 1991 and was not subject to the Sequence Listing Rules. Hence, neither a paper nor computer readable sequence listing was prepared. Because the sequence data found in the present application is not available in computer readable form, the Applicants would have to manually enter and format numerous peptide and nucleotide sequences which would require a huge expenditure of time and expense without providing commensurate benefit to either the U.S. Patent & Trademark Office or the public especially in view of the fact that none of the sequences are being claimed (nor were they claimed in the parent or grandparent applications). Further, amending the specification and the drawings to recite SEQ ID NOS. would add to the excessive burden particularly in view of the complexity and length of the specification and in fact may result in the necessity of filing a second "substitute specification" for this application, which in turn would add to the Examiner's burden in examining this application.

Furthermore, Applicants respectfully submit that the allowance and issuance of the parent and grandparent applications described above indicate that sequence information contained therein was in a format that allowed appropriate searches to be made and which allowed the Draftsman to accurately present the disclosed sequences, both of which underlie the rationale for requiring sequence listings. *See M.P.E.P. 2420.*

Because manually entering and formatting the sequence data found in the present application as well as amending the specification, preparing new drawings, and the possibility of having to prepare a second substitute specification would be excessively time consuming, prohibitively expensive, and without commensurate benefit to the Patent Office or the public, the Applicants respectfully request that the Sequence Listing Rules be waived with respect to the present application.

Application No. 09/417,478  
Filed: October 13, 1999



Docket No. 13839-00010

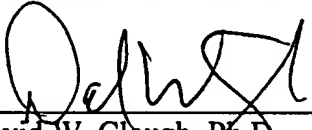
**CONCLUSION**

In view of the foregoing, the Applicants believe that because of the "exceptional circumstances" described herein, the Sequence Listing Rules may be properly waived with respect to the present application and waiver is hereby requested.

The Commissioner is hereby authorized to charge any additional fees which may be required in this application to Deposit Account No. 50-1214.

Respectfully submitted,

KATTEN MUCHIN ZAVIS

By:   
David W. Clough, Ph.D.  
Registration No.: 36,107

Dated: October 2, 2001  
KATTEN MUCHIN ZAVIS  
525 W. Monroe Street, Suite 1600  
Chicago, IL 60661  
Telephone: (312) 902-5464  
Fax: (312) 577-8736



32729B  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/417,478 10/13/99 MCCAFFERTY

3 28111/32/29B

JILL F UHL  
MARSHALL O'TOOLE GERSTEIN HURLEY & BORLIN  
6800 SEARS TOWER  
233 SOUTH WACKER DRIVE  
CHICAGO IL 60605-6402

HM12/U730



EXAMINER

PONNALURTEL

ART UNIT

PAPER NUMBER

1627

DATE MAILED:

07/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

*Marvin Ellis*  
*Reply due*  
*8/30/2001*

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AUG 3 2001

MARSHALL O'TOOLE

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JUL 29 2002

OFFICE OF PETITIONS



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/417,478	10/13/99		



EXAMINER	
P. Ponnaluri	
ART UNIT	PAPER NUMBER
1627	14
DATE MAILED:	

Please find below a communication from the EXAMINER in charge of this application

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

**APPLICANT IS GIVEN A ONE MONTH EXTENDABLE PERIOD WITHIN WHICH TO COMPLY WITH THE SEQUENCE RULES, 37 CFR 1.821 - 1.825.** Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136. In no case may an applicant extend the period for response beyond the six month statutory period. Applicant is requested to return a copy of the attached Notice to Comply with the response.

Any inquiry concerning this communication should be directed to P. Ponnaluri whose telephone number is (703) 305-3884. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached at (703)308-2439. The fax number for this group is (703)305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)308-0196.

P. Ponnaluri  
Patent Examiner  
Technology center 1600  
Art Unit 1627  
22 July 2001

  
PADMASHRI PONNALURI  
PRIMARY EXAMINER

RECEIVED  
JUL 29 2002  
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**NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES**

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- ☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to these regulations, published at 1114 OG 29, May 15, 1990 and at 55 FR 18230, May 1, 1990.
- ☒ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ☒ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- ☐ 7. Other: *This application is a continuation of application 08/484,893, and do not benefit the filing date of prior International application for Sequence compliance rules.*

**Applicant Must Provide:**

- ☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216

For CRF Submission Help, call (703) 308-4212

PatentIn Software Program Support (SIRA)

Technical Assistance.....703-287-0200

To Purchase PatentIn Software.....703-306-2600

**PLEASE RETURN A COPY OF THIS NOTICE WITH YOUR RESPONSE**

**Attachment for PTO-948 (Rev. 03/01, or earlier)**  
**6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.